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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,785	01/31/2002	Robert H. Folk II	D2737	3363

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EXAMINER

NGUYEN, JIMMY H

ART UNIT	PAPER NUMBER
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2673

3

DATE MAILED: 09/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/062,785

Applicant(s)

FOLK, ROBERT H.

Examiner

Jimmy H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This Office Action is made in response to applicant's papers filed on 01/31/2002. Claims 1-23 are currently pending in the application. An action follows below:

#### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature, "a plurality of remote display interfaces arranged in a peer-to-peer network" of claim 3, "a Personal Video Recorder" of claim 9 and "a communication module adapted to transmit said graphical data received by said input module", lines 4-5 of claim 11, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

3. Claims 12-22 are objected to because of the following informalities: line 1, "9" should be changed to -- 11--, so as to be consistent with the limitations in claim 11, e.g., input module of claim 13, communication module of claim 15, and etc., only being recited in independent claim 11, rather than in claim 9. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 11-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding to claims above, the disclosure, when filed, does not contain sufficient information regarding to the claimed features, “a communication module adapted to transmit said graphical data received by said input module” and “a remote server operatively connected to the communication module for receiving the graphical data”, lines 4-7 of independent claim 11 as to enable one skilled in the pertinent art to make and use the claimed invention. The disclosure, specifically fig. 3 and page 6, lines 10-11, discloses “a server interface 62 receives and processes the graphic data from server 102 via a communication module 134”. In other words, in contrast to the invention of claim 11, the above mentioned disclosure expressly teaches the communication module (134) adapted to receive the graphical data from the server 102 and to transmit the graphical data to the server interface 62. Furthermore, since there is no connection between the communication module (134) and the input module (76), how the communication module (134) transmits the graphical data to the input module (76).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim above, it is not clear what the Applicant means "said instruction from said input device" (see line 6 of claim 1), or "said instruction from said remote server" (see line 10 of claim 1).

8. It is noted Applicant that due to the rejections under 35 USC 112 to claims 1-22, the following art rejections to these claims are based as best understood by the Examiner.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2 and 4-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al. (USPN: 6,593,973 B1), hereinafter Sullivan, and further in view of Jambhekar et al. (USPN: 5,848,356), hereinafter Jambhekar.

As per claims 1, 11 and 23, Sullivan discloses a device and an associate method for incorporating a graphic with a received video broadcast displayed on a display device, the device comprising a remote server (a network 118) for providing a graphic data (a superimposed video signal, col. 3, lines 1-6) to a communication module (a network adapter or modem, col. 2, line 39) and a display device (a display device comprising elements 122, 124, 126, 128, 202, 20, 227 and 228, see fig. 1) adapted to display a broadcast video received from a CATV (110) or a satellite (112) and the graphic data from the remote server, and comprising a display interface (a display interface comprising elements 122, 124, 126, 202, 20, 227 and 228, see fig. 1) for overlaying the graphic data on the received broadcast video (fig. 1, col. 2, line 51 through col. 3,

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line 6). Accordingly, Sullivan discloses all the limitations of claims 1 and 11 except for an input device adapted to receive, to store an instruction corresponding to a graphic data and to transmit graphic data to a remote server.

However, Jambhekar expressly teaches an input device (a radio communication 103, fig. 1) adapted to receive and to store an instruction corresponding to a graphic data and to transmit graphic data to a remote server (a remote transceiver 101) (figs. 10s). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide an input device in the device of Sullivan, in view of the teaching in the Jambhekar, because this would provide a user an easier way to compose and to transmit his message to others, as taught by Jambhekar (col. 8, line 60 through col. 9, line 5).

Regarding to claims 2 and 12, as noting in fig. 10, Jambhekar further teaches the instruction including destination address information (see step 1030 and 1032) and the step of transmitting the graphic data to a remote server, in order to transmit the graphic data (an email or a fax or a message) to the selected recipient only.

Regarding to claims 4 and 13, as noting in fig. 10C, Jambhekar further teaches the input device comprising a stylus and a touch screen device.

Regarding to claims 5 and 15, as noting in fig. 1, Jambhekar further teaches the input device being a wireless handheld communicating device.

Regarding to claims 6 and 16, Sullivan further teaches the remote server (118) comprising an Internet server (col. 5, lines 7-8).

Regarding to claims 7 and 14, Jambhekar further teaches that the remote server (101) can be considered as an addressable set-top box for directly transmit the user instruction from the input device (103) to selected recipient (fig. 1).

Regarding to claims 8 and 20, Sullivan's the display interface can be considered as a set-top box adapted to overlay graphics images on a received video broadcast displayed on a display device (fig. 1, col. 2, line 51 through col. 3, line 6).

Regarding to claims 9 and 22, Sullivan's remote server (118) and display interface can considerably comprises a personal video recorder adapted to receive and to overlay the graphical data on the broadcast video (fig. 1 and col. 2, line 32 though col. 3, line 6).

Regarding to claim 10, Sullivan further teaches the display device comprising a television in order to receive a television signal via a CATV (110) (fig. 1).

Regarding to claims 17 and 19, Sullivan further teaches the communication module comprising a modem for receiving the data from the network (col. 2, line 41).

Regarding to claim 18, Sullivan further teaches the remote server comprising a computer (col. 4, lines 27-31).

Regarding to claim 21, Jambhekar further teaches the graphical data comprising text (fig. 10C).

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan in view of Jambhekar as applied to claim 1 above, and further in view of Dailey (USPN: 5,642,350).

Regarding to claim 3, as discussed above, Sullivan teaches a display interface, but does not expressly teach a plurality of remote display interfaces arranged in a peer-to-peer network.

Accordingly, Sullivan in view of Jambhekar discloses all the limitations of claim 3 except for a plurality of remote display interfaces arranged in a peer-to-peer network.

However, Dailey expressly teaches that a plurality of remote devices arranged in a peer-to-peer network to permit every device on the network to initiate as well as receive messages from other devices on the network is well-known to those of ordinary skill in the art (col. 2, lines 14-17). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide a plurality of remote display interfaces arranged in a peer-to-peer network in the device of Sullivan because this would permit every device on the network to initiate as well as receive messages from other devices on the network, as taught by Dailey (col. 2, lines 14-17).

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is (703) 306-5422. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at (703) 305-4938.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**




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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the Technology Center 2600 Customer Service Office whose telephone  
number is (703) 306-0377.

JHN  
September 20, 2003



Jimmy H. Nguyen  
Examiner  
Art Unit: 2673